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In re Application of
HONIG et al.
Serial No.: 09/700,443
PCT No.: PCT/EP99/02947
Int. Filing Date: 30 April 1999
Priority Date: 08 May 1998
Attorney's Docket No.: FA-0973
For: ELECTRO-DIPCOATING BATHS WITH
ADDITIVES PREVENTING THE FORMATION OF
CRATERS IN THE BAKED COATING

DECISION ON
PETITION
UNDER 37 CFR 1.10(d)

This decision is in response to "PETITION UNDER 37 CFR§1.10(d) or In The Alternative, under 37 CFR §1.137 (b)" filed 19 January 2001 requesting that the above-identified application be accorded a filing date for national stage papers of 08 November 2000, the date petitioner avers that the application was deposited via "Express Mail" pursuant to 37 CFR 1.10.

BACKGROUND

On 30 April 1999, applicant filed international application No. PCT/EP99/02947, which claimed a priority date of 08 May 1998 and which designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 18 November 1999.

On 30 November 1999, a Demand was filed with the International Preliminary Examining Authority electing the United States. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or on 08 November 2000.

Applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, *inter alia*, a copy of the international application, a small entity statement and the basic national fee, which the United States Designated/Elected Office (DO/EO/US) accorded a filing date of 09 November 2000.

A review of the application file reveals that the original Express Mail label indicates a "Date-In" of "11/09/00". The original application papers were date stamped as received by the United States Patent and Trademark Office (USPTO) on 09 November 2000.

On 07 December 2000, a Notification of Abandonment was mailed to applicants

indicating that applicant had failed to provide the U.S. Basic National Fee by 30 month deadline and that the application was abandoned as to the U.S.

DISCUSSION

37 CFR 1.10(d)

Petitioner has submitted a copy of the "Express Mail" customer receipt bearing the same "Express Mail" mailing number as identified on the transmittal letter that accompanied the application papers. The addressee's copy of the "Express Mail" mailing label No. "EL031052691US" located in the application file also bears the entry in the "Date-In" box on the label of 09 November 2000. The addressee copy in the application file bears a PTO Mail Center date stamp of "Nov 09 2000". However, the showing that the original papers were, in fact, deposited as "Express Mail" with the United States Postal Service (USPS) on 08 November 2000 is insufficient to overcome the USPS evidence.

37 CFR 1.10(d) provides relief in the instance where the USPS has omitted from the "Express Mail" mailing label the "date-in" date. Specifically, 37 CFR 1.10(d) provides as follows:

Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Commissioner to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail";

(3) The petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS. Any statement submitted in support of such a showing pursuant to this paragraph must be a verified statement if made by a person other than an employee of the USPS or a practitioner as defined in § 10.1(r) of this chapter.

Petitioner has satisfied item (1) above as the petition is considered promptly filed. Item (2) above is satisfied since the number of the "Express Mail" mailing label "EL031052691US" was placed the transmittal letter prior to the original mailing by "Express Mail".

However, with regard item (3), the customer copy of the Express Mail label shows a "Date-In" of "11/9/00". The post card receipt indicates 09 November 2000. When papers are filed via Express Mail, the USPTO stamps the *date of deposit* as the date of receipt. See 37 CFR 1.10.

Applicant's submission of a daily log sheet for 08 November 2000 provides the attorney docket number (FA-0973), application number (EP99/02947), document title (National), attorney initials (JAT), fee (\$1210) and a checkmark in the box marked "Mail". Counsel's statement indicates that he maintains daily logs used to record all outgoing mail to the USPTO on any

given day. Counsel does not state that the log is created "within one day after the deposit of the correspondence as 'Express Mail'". *See* MPEP 513, p.500-47 (Rev.1, Feb 2000). Furthermore, the daily log submitted does not contain: (1) the "Express Mail" number; (2) the place, date and time of deposit; (3) the time of the last scheduled pick-up for that date and place of deposit; (4) the depositor's initials or signature; and (5) the date and time of entry in the log. *Id.* Nor does applicant provide the Corporate Account Mailing Statement as evidence of the date of deposit. Therefore the evidence provided is insufficient to establish that the correspondence was deposited with the USPS on 08 November 2000.

Accordingly, it is inappropriate, on the present record, to accord the application a corrected filing date of 08 November 2000.

Furthermore, in compliance with 37 CFR 1.495(b), an international application becomes abandoned if the copy of the international application or the basic national fee has not been received by the U.S. Designated Office prior to the expiration of 30 months from the priority date or in this case, by 08 November 2000. The time for payment of the basic national fee is not extendable. *See* MPEP §1893.01(b)(1). Thus, the application is abandoned as to entry into national stage in the United States.

37 CFR 1.137(b)

Applicant requests that, in the alternative to the petition under 37 CFR 1.10(d), the petition be construed as a petition to revive under 37 CFR 1.137(b). The petition to revive under 37 CFR 1.137(b) filed 19 January 2001 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statements that "any abandonment of the application was unintentional" and that "[t]he delay between the receipt of the Notification of Abandonment on December 14, 2000 and the filing of this petition, in addition to the intervening holidays, was occasioned by the need to review the facts, identify and collect the necessary evidence and prepare this petition" has been interpreted as meaning that "entire delay in filing the required reply from the due date for the reply until the filing of this petition under 37 CFR 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3) at the time of filing this petition. If this is an incorrect interpretation in view of the rules, petitioner is required to promptly notify this office.

A review of the application file reveals that applicant has authorized payment of the required petition fee of \$1240 from his deposit account and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

CONCLUSION

Applicant's petition under 37 CFR 1.10(d), requesting that the national stage application papers be accorded a filing date of 08 November 2000 is **DISMISSED without prejudice**.

Any reconsideration on the merits of this petition must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled " Renewed Petition Under 37 CFR 1.10." Extensions of time may be obtained under 37 CFR 1.136(a).

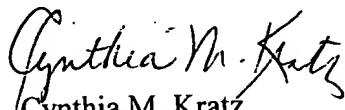
Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Applicant's petition to revive under 37 CFR 1.137(b) is **GRANTED**.

The application is being forwarded to the U.S. Designated Office for further processing including issuance of the Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration executed by the inventors and the \$130 surcharge for filing the oath or declaration after the thirty month period is required.



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